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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Sno Wizard Holdings, Inc.

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Serial No. 78279166

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Seth M. Nehrbass of Garvey, Smith, Nehrbass & Doody, L.L.C. for Sno Wizard Holdings, Inc.

Tina L. Snapp, Trademark Examining Attorney, Law Office 116 (M. I. Hershkowitz, Managing Attorney).

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Before Walters, Grendel, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 25, 2003, Sno Wizard Holdings, Inc. (applicant) applied to register the mark NOBODY BEATS THE WIZ! in typed or standard character form on the Principal Register for goods identified as “ice-shaving machines” in Class 7. Serial No. 78279166. The application is based on an allegation of a bona fide intention to use the mark in commerce.

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d) on the ground that applicant's mark, when used on the identified goods, is likely to cause confusion, to cause mistake, or to deceive in view of two prior registrations for the mark NOBODY BEATS THE WIZ in typed or standard character form. The first registration (No. 1,395,362) issued May 27, 1986, and affidavits under Section 8 and 15 have been accepted or acknowledged.[1] The services in the registration are listed as "retail store services for audio and visual equipment and accessories, electrical appliances, and records and tapes." The second registration (No. 1,905,190) issued July 11, 1995, and it was been renewed. The registration is for "retail store services in the fields of audio and video equipment and accessories, computers and computer equipment and accessories, office equipment and accessories, computer software, photographic equipment, and household appliances." The owner of both registrations is listed as P.C. Richard & Son.

After the examining attorney made the refusal final, this appeal followed.

[1] The electronic records indicate that a new certificate under Section 7(d) has issued. 15 U.S.C. § 1057(d) ("A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the Patent and Trademark Office").

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by looking at the similarities and dissimilarities of applicant's and registrant's marks. When we consider the marks, we look to see whether they are similar in appearance, sound, connotation, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691-92 (Fed. Cir. 2005). Applicant's mark is NOBODY BEATS THE WIZ! and registrant's marks are NOBODY BEATS THE WIZ. The examining attorney argues that "the marks are virtually identical." Brief at 3. Applicant does not argue that there are any significant differences in the

marks and we agree that the marks are identical except for the fact that applicant adds an exclamation point in its mark. This punctuation mark does not significantly change the commercial impressions of the marks. In re Burlington Industries, Inc., 196 USPQ 718, 719 (TTAB 1977) ("[A]n exclamation point does not serve to identify the source of the goods"). Accord Seaguard Corp. v. Seaward International, Inc., 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical"). But for the exclamation point, the appearance of the marks is identical. In addition, the marks' pronunciation, meaning, and commercial impression would be identical. We also add that there is no evidence that the mark NOBODY BEATS THE WIZ is weak for the identified goods and services.

When marks are virtually identical, the goods and services do not have to be as closely related to hold that there is a likelihood of confusion. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

The next factor we consider is whether applicant's ice-shaving machines and registrant's retail store services are related. The examining attorney points out that

registrant's retail stores services are in the fields of "household appliances" (No. 1,905,190) and "electrical appliances" (No. 1,395,362). The examining attorney held "that applicant's goods are related to the registrant's services in that electrical appliances or household appliances featured by the registrant's retail store services may reasonably encompass the applicant's ice–shaving machines." In support of her position, the examining attorney submitted several Internet printouts that show retail sales of ice shaving machines. For example, Goodman's (www.goodmans.net) displays a "Rival IS450-WB deluxe ice shaver." Its price is listed as $33.95 and it is described as follows:

> [D]eluxe ice shaver. Makes great frozen drinks and snow cones. Has powerful motor for fast ice shaving, push button controls, and extended collecting platform. Includes snow cone molder and 2 flavor packets, blue rasberry [sic] and grape.

Another search at BizRate.com identified the following ice shavers:

Salton Electric Ice Shaver - $24.95

Salton ISP2 Ice Shaver/Snow Cone Maker - $18.99

Another site (YahooShopping.com) lists several ice shavers including:

Hamilton Beach Snowman Ice Shaver - $19.83

Deluxe Electric Ice Shaver Set - $74.99

> Back to Basics Ice Shaver - $59.95
> Effortlessly turns cubed and crushed ice into soft, fluffy snow in seconds.

This evidence supports the position that there are ice-shaving machines that are sold at retail to ordinary purchasers. An "appliance" is defined as "a machine, such as a dishwasher, used to perform a household task." "Household" is defined as: "Of or relating to or used in a household: Household appliances." *The American Heritage Student Dictionary* (1994).[2] The ice shavers discussed above are electrical appliances used in to perform household tasks such as making snow cones and drinks.

We must consider the goods and services as they are identified in the application's and registrations' identification of goods and services. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the

[2] We take judicial notice of these definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("'Likelihood of confusion must be determined based on an analysis of the mark applied to the … [goods or] services recited in applicant's application vis-à-vis the … [goods or] services recited in [a] … registration, rather than what the evidence shows the … [goods or] services to be'"). While applicant argues that there is no evidence that "a store similar to the registrant sells ice shaving machines" (Brief at 1), this is not required. The evidence demonstrates that retail stores that sell household and electrical appliances could also sell ice-shaving machines.

Clearly, applicant's goods, identified as "ice-shaving machines," are not limited in any way and, therefore, they would include the types of ice shavers that would be sold at retail. Furthermore, these goods would be considered household and electrical appliances. Registrant's retail store services include, inter alia, the sale of electrical and household appliances. Therefore, applicant's ice

shaving machines could be sold in retail stores that sell household and electrical appliances. The Federal Circuit has addressed the question of the relatedness of goods and retail store services in a case that involved whether the mark "bigg's" (stylized) for "retail grocery and general merchandise store services" and BIGGS and design for "furniture" were related.

> The only aspect of this case which is unusual is that the marks sought to be registered are for services while the prior registration on which their registration is refused is for wares. Considering the facts (a) that trademarks for goods find their principal use in connection with selling the goods and (b) that the applicant's services are general merchandising -- that is to say selling -- services, we find this aspect of the case to be of little or no legal significance.
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> In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (Court agreed that there was a likelihood of confusion).

Based on the record, we conclude that the goods and services in this case are related.

We add that in "order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely

to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989).

Here, the marks are for the identical words, NOBODY BEATS THE WIZ. Registrant's retail store services include the sale of electrical appliances and household appliances. Prospective purchasers familiar with registrant's retail store services that would include the sale of ice shavers are likely to believe that there is some association when they would encounter the identical words used as a mark on ice-shaving machines.

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.